

**REMARKS/ARGUMENTS**

Upon entry of the above amendment, claims 1, 3, 6, 8, 11, 13, 16, 18, 20, 22, 24, 26, 28, 30 and 32 will have been amended for consideration by the Examiner. In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided, and for the acknowledgment of Applicant's claim for priority under 35 U.S.C. § 119 and receipt of the certified copies of the priority documents in the parent application, as set forth in the Official Action. Applicant further notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statements filed in the present application on April 1, 2004, July 6, 2004 and March 3, 2005 by the return of the initialed and signed PTO-1449 Forms, and for consideration of the documents cited in the Information Disclosure Statements.

Turning to the merits of the action, the Examiner has rejected claims 1-5, 11-17, 20-23, 26-29, and 32-33 under 35 U.S.C. § 103(a) as being unpatentable over LEE et al. (U.S. Patent No. 5,742,769). The Examiner has rejected claims 6-10, 18-19, 24-25, and 30-31 under 35 U.S.C. § 103(a) as being unpatentable over LEE et al. (U.S. Patent No. 5,742,769) in view of WEBER et al. (U.S. Patent No. 5,878,230).

However, Applicant respectfully traverses the above rejections.

As noted above, Applicant has amended claims 1, 3, 6, 8, 11, 13, 16, 18, 20, 22, 24, 26, 28, 30 and 32 for consideration by the Examiner. Applicant respectfully traverses the above rejection based on the pending claims and will discuss said

rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 1-21 generally relate to an image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network. The e-mail includes a mail from command and a mail message. The image data communication apparatus includes a memory which stores a mail address of at least one user. The memory is within the image data communication apparatus. The image data communication apparatus includes a panel which selects the mail address of at least one user stored in the memory. The image data communication apparatus further includes controller configured to set the mail address of the user selected by the panel into the mail message of the e-mail to which the image data is attached. The mail address of the user is distinct from a mail address of the image data communication apparatus. Then, the mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus. Thus, reply is returned to the mail address of the user, and not to the image data communication apparatus. Claims 22-33 recite related methods.

Regarding the rejection of claims 1-5, 11-17, 20-23, 26-29, and 32-33, LEE et al. relates to a system in which individual users 10 can access the directory service 24 to obtain directory information about a very large number of people and businesses (col. 2, lines 16-33). The users 10 can register basic directory information, i.e., names, addresses, and telephone numbers into the storage 30 of the directory service 24 (col.

2, lines 34-43, col. 4, lines 63-67, and col. 5, lines 1-16). The users 10 can search in the directory service 24 for the directory information of other users 10 (col. 2, lines 43-65, col. 6, lines 48-67 and col. 7, lines 1-12).

However, LEE et al. does not disclose an image data communication apparatus which has a memory configured to store a mail address of at least one user, the memory being within the image data communication apparatus. Rather, in LEE et al., the user 10 is a sender but does not include a storage that registers directory information. In LEE et al., the directory service 25 which is not a sender (but is distinct and generally remote from the users 10) contains the storage 30 that registers the directory information. In other words, in LEE et al., the sender is distinct from the directory service 25 that contains the storage 30. On the other hand, in the present invention, the image data communication apparatus transmits image data and has a memory that stores a mail address of at least one user. The memory is within the image data communication apparatus that transmits image data.

Further, LEE et al. does not disclose an image data communication apparatus which sets the mail address of the user selected by the panel into the mail message of the e-mail to which the image data is attached, the mail address of the user being distinct from a mail address of the image data communication apparatus, whereby the mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the mail address of the user, and not being returned to the image data communication apparatus.

Rather, in LEE et al., the sender sets a sender's e-mail address into a "Reply-to" field; therefore, a reply to a sending e-mail is returned to the sender that has transmitted the sending e-mail (col. 7, lines 26-63). In other words, LEE et al. merely disclose a conventional reply mail.

On the other hand, and in stark contrast to LEE et al., the present invention recites an image data communication apparatus which sets the mail address of the user selected by the panel into the mail message of the e-mail to which the image data is attached. The mail address of the user is distinct from a mail address of the image data communication apparatus. Thus, in the present invention, the mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus. Thus, the reply is returned to the mail address of the user, but not to the image data communication apparatus.

Thus, the pending claims are clearly distinct from LEE et al.

Therefore, it is respectfully submitted that the features recited in Applicant's resubmitted claims are not disclosed in LEE et al. cited by the Examiner.

Regarding the rejection of claims 6-10, 18-19, 24-25, and 30-31, WEBER et al. discloses a system in which when a user at an individual computer 12 or 30 composes an e-mail for distribution to one or more other individual computers 12 or 30, the e-mail system automatically generates a reply attribute that indicates that reply to the original message will be directed to the sender or originator.

However, WEBER et al. does not disclose an image data communication apparatus which sets the mail address of the user selected by the panel into the mail

message of the e-mail to which the image data is attached, the mail address of the user being distinct from a mail address of the image data communication apparatus, whereby the mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the mail address of the user, and not being returned to the image data communication apparatus.

Rather, in WEBER et al., the sender sets a sender's e-mail address into an e-mail so that reply to the original message will be directed to the sender or originator. In other words, WEBER et al. also merely discloses a conventional reply mail. On the other hand, the present invention recites an image data communication apparatus which sets the mail address of the user selected by the panel into the mail message of the e-mail to which the image data is attached. The mail address of the user is distinct from a mail address of the image data communication apparatus. Thus, in the present invention, the mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus. The reply is returned to the mail address of the user, but is not returned to the image data communication apparatus.

Thus, the pending claims are clearly distinguished over WEBER et al.

Therefore, it is respectfully submitted that the features recited in Applicant's resubmitted claims are not taught or disclosed in WEBER et al. cited by the Examiner. Claims 1-33 are also submitted to be patentable over the Examiner's proposed combination. In particular, since neither LEE et al. nor WEBER et al. disclose the

features recited in Applicant's claims 1-33, claims 1-33 are clearly distinguished over the combination of LEE et al. and WEBER et al.

Additionally, Applicant notes that the Examiner has not set forth any proper evidentiary support for his assertion of obviousness of the combination of LEE et al. and WEBER et al. The Examiner has merely asserted that the combination would be obvious. A mere assertion of obviousness, without any supporting evidence and motivation for the proposed combination, is inadequate under 35 U.S.C. § 103 to render a claim unpatentable.

Additionally, Applicant respectfully submits that there is no proper motivation for the modification of the teachings of LEE et al. by the teachings of WEBER et al. In particular, LEE et al. is directed to a directory which enables a user to hide his address (i.e., not to reveal his or her address to a sender). In contrast, WEBER et al. is directed to message routing to a third party. There is no reason why one should modify the directory service of LEE et al. with the third party routing of feature of WEBER et al. While both of these documents deal with e-mail, this in and of itself is an inadequate basis for rendering the Examiner's proposed combination obvious and properly motivated.

Applicant further wishes to make of record a telephone interview conducted between Applicant's undersigned representative and Examiner Lee who is in charge of the present application. During the above-noted interview, which was conducted on November 3, 2005, Applicant's representative pointed out the significant and substantial differences between the disclosures of the references and the recitations of Applicant's claims. During the above-noted interview, Applicant's representative noted

that LEE et al. discloses a storage for the e-mail addresses, which is part of the directory service 24, is distinct and remote from the users 10. In particular, Applicant notes that access to the directory service is through the Internet via the two Internet providers 20 and 26. In direct contrast, Applicant's claims have been amended to even more clearly emphasize that the memory recited in the claims is part of the image data communication apparatus.

Additionally, Applicant pointed out that according to the teachings of the present invention the image data communication apparatus transmits image data to a receiving apparatus but that the mail address of the user is distinct from a mail address of the image data communicating apparatus. Similarly, as a feature of the present invention, the reply which is sent by the receiving apparatus is returned to the mail address of the user rather than being returned to the image data communication apparatus. Both of these additional features clearly and unambiguously even more distinguish Applicant's claimed invention from the LEE et al. and WEBER et al. systems. In particular, LEE et al. is directed to an ordinary conventional reply which goes back to the transmitter of the data as can clearly be seen in column 7, lines 30-35 where the contents of the "from" and "reply to" lines are identical.

At the conclusion of the interview, the Examiner indicated that he understood the distinctions between the claims which define the present invention and the disclosures of the references relied upon and that he believed that the claimed amendments even more clearly emphasize these distinctions. The Examiner, however, reserved judgment until a response is filed, the exact language of the proposed changes is clear

to him and he is able to review the references with respect thereto as well as to conduct an update search.

During the above-noted interview, Applicant's undersigned representative further discussed the status of 15 co-pending applications of which the present application is one. The Examiner noted that each of these applications are on his docket and noted that he has and will be examining all of them. Applicant's undersigned representative respectfully requested that the Examiner in maintaining a complete record of the present family or cases by citing, in each application, all of the references cited in any previous applications so that the burden on Applicant to update the cited prior art in each of the applications is somewhat ameliorated. The Examiner indicated that he would do so and Applicant respectfully thanks the Examiner for his cooperation.

The Examiner is respectfully thanked for his cooperation and courtesy as exhibited during the above-noted interview as well as for his cooperative nature and for his willingness to schedule and conduct the interview at a mutually agreeable time.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application, in due course.




**SUMMARY AND CONCLUSION**

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has amended the rejected claims for reconsideration by the Examiner. With respect to the rejected claims, Applicant has pointed out the features thereof and has contrasted the features of the rejected claims with the disclosure of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
Hidehiko OGAWA

  
Bruce H. Bernstein  
Reg. No. 29,027

William Pieprz  
Reg. No. 33,630

November 8, 2005  
GREENBLUM & BERNSTEIN, P.L.C.  
1950 Roland Clarke Place  
Reston, VA 20191  
(703) 716-1191